

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re FG Industries, Inc.

Serial No. 74/686,523

Thomas M. Onda and Sarah A. Cunniff of Steinhart & Falconer
for applicant.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

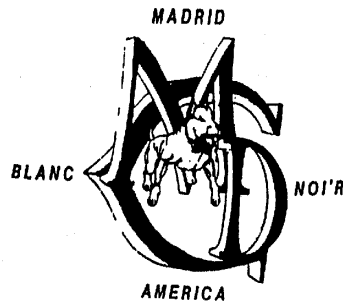
Before Seeherman, Walters and McLeod, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

FG Industries, Inc. has filed a trademark application
to register the mark BLANC NOIR for "casual wear, namely
shorts, skirts, pants, jackets, socks, shoes and hats."¹
The application includes the statement "Blanc Noir is
French for White Black."

The Trademark Examining Attorney has finally refused
registration under Section 2(d) of the Trademark Act, 15

U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "clothing and outer wear, namely, T-shirts, jean sweat shirts, sweat pants, jackets, shorts, pants, and caps and hats,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive. The registration includes a disclaimer of MADRID and AMERICA apart from the mark as a whole; and the statement "the English translation of the words BLANC and NOIR is 'white' and 'black'."



Applicant has appealed. Both the applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

¹ Serial No. 74/686,523, in International Class 25, filed June 7, 1995, based on use in commerce, alleging dates of first use and first use in commerce as of February 11, 1991.

² Registration No. 2,103,725 issued October 7, 1997, to Toni J. Prados, in International Class 25.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See, In re E. I. duPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion in this case, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the goods, except for "socks," "shoes," and "skirts," the items listed in applicant's identification of goods are identical to the same items listed in the cited registration. "Skirts" are clothing items reasonably related to several of registrant's other items of clothing, such as "pants" and "shorts." It is unnecessary, in view of the identity of the other items in the application and registration, to determine whether applicant's recited "socks" and "shoes" are related to the items of clothing in the cited registration. Additionally, the fact that applicant's goods are characterized as "casual wear" and registrant's goods are characterized as "clothing and outer wear" is insignificant. As neither identification of goods is limited, we assume that the

goods travel in all the normal channels of trade to the usual consumers of such goods.

We turn, next, to a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are sufficiently similar in terms of appearance, sound, connotation and commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

The Examining Attorney contends that BLANC NOI'R is the dominant portion of registrant's mark and is identical to applicant's mark; that the "subordinate features" of the registered mark do not distinguish it from applicant's mark; that the letters MDC in registrant's mark "are so stylized and intertwined with the bulldog design that [the letters] would be perceived as part of the design"; that "the design features [of registrant's mark] are less likely to be impressed upon a purchaser's memory, as the literal portion would be most likely remembered and used in calling for the goods [and] [t]hese features would therefore have little or no origin indicating significance in distinguishing the goods of registrant from those of others"; and that MADRID and AMERICA have little significance in registrant's mark as they merely indicate the geographic origin of the goods.

Applicant contends, on the other hand, that the registrant's mark "is a complex composite mark, consisting of stylized initials, 'MDC,' several times larger than any other element in the mark and displayed in the center[;] a drawing of a bulldog is superimposed on the initials[;] the remaining words are in much smaller print, arrayed at compass points around the central figure[;] [and] the words are arranged in clockwise order beginning from the top, MADRID NOI'R AMERICA BLANC."

We agree with the Examining Attorney that, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). However, we disagree with the Examining Attorney's conclusions in this regard and agree with applicant that the large and central design element, incorporating the letters MDC, is the dominant portion of registrant's mark. While we believe that the words around the design are intended to be read across, as "BLANC NOI'R," and down, as "MADRID AMERICA," we find these words to be significantly smaller than, and peripheral to, the letters MDC and the

design element of the mark. While the Examining Attorney is correct that words often predominate over design elements in a mark, it is not always the case, and, in particular, it is not the case herein. Further, the design element prominently features the letters MDC, which is a literal portion of the mark and may be used in calling for the goods.

Therefore, we conclude that in view of the substantial differences in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on even the same or related goods involved in this case is not likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal under Section 2(d) of the Act is reversed.

E. J. Seeherman

C. E. Walters

L. K. McLeod
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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